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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,276

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Takashi Nakao

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EXAMINER

TAOUSAKIS, ALEXANDER P

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

12/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,276	Applicant(s) NAKAO ET AL.	
	Examiner ALEXANDER P. TAOUSAKIS	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/08/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/09/2009, 09/06/2007, 05/12/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-3 in the reply filed on 10/08/2009 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the first step" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the second step" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the third step" in line 21. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the first step" in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the second step" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the third step" in line 23. There is insufficient antecedent basis for this limitation in the claim.

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Claim 3 recites the limitation "the corner portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the side face" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

Claim 2 is objected to because of the following informalities: In line 2, "throttle body of the throttle body" should be changed to ---throttle body, the throttle body---. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by SIAM (GB655467).

1. SIAM teaches a method of assembling a gasket, the gasket is fitted into a groove formed in the face of a member and confronting another member (*see Figure 3*), the gasket being compressed between two members, the gasket being formed into a generally pentagonal shape having two inclined faces forming a section of an angle shape and a leading end of a round section and a bottom face in contact with the groove, comprising:

a first step of fitting the gasket body in the fitting groove (*see Figure 3 and page 2 lines 70-76*);

a second step of bringing the leading end of the two inclined faces into contact with only the close contact face of the other member (*see Figure 3 and page 2 lines 99-117*); and

a third step of assembling the two members having the gasket body fitted therein, wherein the leading end is in sliding contact with the close contact face (*see Figure 8 and page 3 lines 2-25, where it discloses the gasket being in sliding contact with the other member and deforming sideways into the by the relative movement of the two members*).

Note that the preamble language directed to the two members being oblique is not accorded patentable weight because the body of the claim does not depend on the preamble for completeness, but the structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951)). The body of the claim does not require a certain structure for the two mating members, and therefore no weight is given to the limitation in the preamble pertaining to the structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (JP10103089) in view of SIAM (GB655467).

2. Suzuki teaches a method of assembling a gasket (8), which is fitted into a fitting groove formed in the face of a throttle body (3) (*see Figure 1*), the throttle body and an intake manifold (4) having confronting faces (*see Figure 1*), and the gasket is compressed when the throttle body is assembled with the intake manifold (*see Figure 1*), where the faces are oblique (*see the confronting faces at 16, which is parallel to member 3b and is clearly oblique as compared to the straight line shown in 3a*) and provides a seal, the method comprising:
fitting the gasket (8) into a fitting groove (*see Figure 1*), the gasket (8) being in sliding contact with the intake manifold (4) (*see Figure 1*).

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Suzuki fails to teach the gasket (8) having a generally pentagonal shape having two inclined faces and a leading end in close contact with the intake manifold then in sliding contact with the intake manifold.

SIAM teaches a method of assembling a gasket, the gasket being formed into a generally pentagonal shape having two inclined faces forming a section of an angle shape and a leading end of a round section and a bottom face in contact with the groove, wherein the gasket body is fitted in a groove (*see Figure 3 and page 2 lines 70-76*), where the leading end of the two inclined faces into contact with only the close contact face of the other member (*see Figure 3 and page 2 lines 99-117*) and wherein the leading end is in sliding contact with the close contact face (*see Figure 8 and page 3 lines 2-25, where it discloses the gasket being in sliding contact with the other member and deforming sideways into the by the relative movement of the two members*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a pentagonal shaped gasket onto the intake manifold of Suzuki, as taught by SIAM, because it allows for slight deformation of the gasket to provide a strong, reliable high pressure seal (*see SIAM page 1 lines 11-27*).

Furthermore, it would have been obvious to assemble the gasket by close contact then sliding contact with the intake manifold, as taught by SIAM, because it allows for gradual building of pressure and to allow for a slight distortion to improve its sealing properties (*see SIAM page 3 lines 2-33*).

3. Suzuki/SIAM teach the method of claim 2 wherein a corner portion of the generally pentagonal section is located on the downstream side in the direction of relative movement of the intake manifold (*see Suzuki Figure 1*) and a side face between the corner portion and the bottom face make close contact with the groove side wall of the fitting groove (*see SIAM Figure 4*).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER P. TAOUSAKIS whose telephone number is (571)272-3497. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander P Taousakis
Examiner
Art Unit 3726

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